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In re Application of :
ARNOLD-HUYSER et al. :
Application No.: 10/532,199 : DECISION
PCT No.: PCT/US03/33284 :
Int. Filing Date: 20 October 2003 :
Priority Date: 21 October 2002 :
Attorney Docket No.: 026032-4901 :
For: POINT OF INTEREST DISPLAY SYSTEM :

This is a decision on applicants' "RENEWED PETITION UNDER 37 C.F.R. 1.47(a)" filed 16 October 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 20 October 2003, applicants filed international application PCT/US03/33284, which designated the United States and claimed a priority date of 21 October 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 06 May 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 April 2005.

On 21 April 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 22 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 23 February 2006, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, a petition/fee for a three-month extension of time, a copy of an e-mail from Jodi Hemmeke to Nathaniel St. Clair, and a copy of a receipt for certified mail.

On 25 April 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort had not been provided and that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor had not been provided.

On 16 October 2006, applicants submitted the instant "RENEWED PETITION UNDER 37 C.F.R. 1.47(a)" which was accompanied by, *inter alia*, a petition/fee for a four-month extension of time, an affidavit of Jodi Hemmeke, a copy of an e-mail from non-signing inventor John Bambini to Jodi Hemmeke dated 18 December 2005, an e-mail from Jodi Hemmeke to John Bambini dated 20 December 2005, an e-mail from Jodi Hemmeke to John Bambini dated 26 January 2006, a copy of a letter from Nathaniel St. Clair II to John Bambini dated 07 February 2006, a copy of a receipt for certified mail, and a copy of an e-mail from Jodi Hemmeke to John Bambini dated 22 June 2006.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 25 April 2006, items (1) and (3) have been met.

Item (2) has not been satisfied. MPEP § 409.03(d), item II, states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Here, it is not clear from the record whether Mr. Bambini was presented with a complete copy of the "application papers (specification including claims, drawings, and an oath or declaration)." MPEP § 409.03(d), item II. While the affidavit of Jodi Hemmeke implies that a copy of the application was sent on or around 09 December 2005 (paragraph 4 of the affidavit), a copy of that communication was not provided. Also, it does not appear from the letter of 07 February 2006 that a copy of the application was included with that letter.

Item (4) has now been met.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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